APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,561	09/30/2003	Axel Spriestersbach	13909-103001 / 2003P00035	6444

32864   7590   07/02/2008
FISH & RICHARDSON, P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
KEEFER, MICHAEL E

ART UNIT	PAPER NUMBER
2154	

MAIL DATE	DELIVERY MODE
07/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/673,561	SPRIESTERSBACH ET AL.
Office Action Summary	Examiner	Art Unit	
	MICHAEL E. KEEFER	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _16 April 2008_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,3-10,13,14,22 and 24-28_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1,3-10,13,14,22 and 24-28_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20080630

DETAILED ACTION

1.   This Office Action is responsive to the Amendment filed 4/16/2008.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 13 and 14 are directed to "an

apparatus comprising a server device". According to applicant's specification "an

apparatus" appears to be "an adaptation framework" which is software per se. This view

is supported by applicant's statement that the amendments to overcome the rejection

under 35 USC 101 find support on pages 15-16, which describe a software framework.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-9, 13-14, 22-23, and 25-27 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Giannetti ("Device Independence Web Application Framework

(DIWAF)") in view of Felciano et al. (US 6052730), hereafter Felciano.

(The Examiner notes that Claim 25 is a combination of Claims 1, 4, 6-7 and 9,

and that claims 13-14, and 23 are substantially the same as claim 1 and claim 9,

thus the rejection of Claim 25 applies equally to those claims as well.)

Regarding **claims 1, 4, 6-7, 9, 13-14, 23, and 25**, Giannetti discloses:

A method comprising:

generating a description of an event and an element in a source document

using a generic, device-independent document description markup language that

has a syntax based on XML, the event representing **a form submission user**

interaction with the element; (the XML based document shown under Fig. 5

describes elements in a device independent document description markup

language. The section marked "Interaction and Navigation" describes the same

format of generic document being used to describe interactions (i.e. events))

associating meta-information about a structure of the source document

with the generically described event, the meta information indicating alternate

representations of the element and enabling the element to be declared optional

and omitted on a client device with insufficient resources; (Fig. 7 shows the meta

information being used to choose an appropriate alternative representation of the

document based off of the resources of the device being used to view the

document. Additionally, below the heading "Selection of Alternative Content"

Giannetti teaches the author being able to give the engine a way of selecting

content to be preserved during adaptation. Inherently, everything that is not set to

be preserved during adaptation is optional and may be omitted by the adaptation engine.)

transforming the generic description of the event and the element into markup language specific representations of the event and the element, respectively, the transforming being controlled at least in part by the associated meta-information; ("Selection of Alternative Content" (the last paragraph on this page) "When the device, from the device class, requests the information, the system will select the most suitable alternative from the available one and will send the content adapted to the device dependent format.")

fragmenting the source document into two or more subdocuments and transforming the fragments into one or more markup language specific representations appropriate to available resources of the client device and an execution environment of the client device; ("Interaction and Navigation" "Implicit navigation can be automatically generated for example to link together elements of a view port that have been split into multiple units for a smaller device")

sending at least one of the markup language specific representations to a browser running on a client device; (See Fig. 1, note the documents being sent to the devices. A browser is inherent for receiving web documents.)

receiving from the client device the event coded as at least one HTTP-request parameter based on the **form submission user interaction** occurring at the browser, the **at least one HTTP-request parameter** including an event name and an event value derived from attributes of the generic

description defining a resource processing the event and a sequence of the event; and (From the section interaction and navigation, it is clear that the document description language version of the event must define a resource processing the event and a sequence of the event (i.e. it lists alt_bind_1 as handling the caption function of the button), which must contain the sequence to be executed when the event occurs, Thus has both the sequence of the event and the resource processing the event. Additionally, as the device dependent document is made using the generic description, any requests sent back to the server from that document are inherently derived from the contents of the generic document.)

invoking a process based on the received at least one HTTP-request parameter. (inherently, whatever functionality is implemented by the button in the interaction section must be invoked when the server receives a notification that the button has been pressed.)

The examiner has highlighted in bold above the elements which are not disclosed by Giannetti.

The general concept of including a form interaction function in a web document is well known in the art as taught by Felciano. (In Col. 6 lines 10-11, it is taught that form interactions are a part of basic web browsing.)

Additionally, the general concept of using http-request parameters to send event and form submission information to a server from a web document is well known in the art as taught by Felciano. (Both Col. 3 lines 39 and 63-66 teach the

use of http requests that incorporate event names and arguments being sent as a result of form interactions on a document.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giannetti with the general concept of including form interaction functions on a web document and the general concept of using http-request parameters to send event and form submission information to a server from a web document as taught by Felciano in order to allow all basic web interaction functions to be supported by the interaction model.

(For clarity, the examiner has only addressed claim 25 and the claims of similar scope as noted above. Below the Examiner will point out why the further claims which are dependent from claim 1 are described and taught by Giannetti, and are thus also obvious to one of ordinary skill in the art when incorporated with the reasons cited above related to claim 1.)

Regarding **claim 3**, Giannetti discloses the source document is a web document, as it is describing a document for use with the world wide web.

Regarding **claim 5**, Giannetti discloses that the generic document is created manually by an author; therefore the metadata is manually associated with the elements.

Regarding **claim 8**, Giannetti discloses automatically transforming the document based off of the generic document (see the above cited section regarding the transformation of the generic document.

Regarding **claim 22**, Giannetti discloses that the transformation is controlled at least in part by style sheets having access to client device information. (See Fig. 7, where it is shown that different devices of different classes are given different alternative views; therefore the transformation is controlled by a style sheet that has access to the type of client device.)

Regarding **claim 26**, Giannetti discloses that the markup language specific representations are not expressed in the generic language. (See the example at the bottom of page 5 (Selection of Alternative Content), which uses XML language formatting to define the alternatives.)

Regarding **claim 27**, Giannetti discloses that the generic language used is not HTML, but is a variant of XML.

4.   **Claims 10 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Giannetti in view of Felciano as applied to claim 1 above, and further in view of Official Notice.

Giannetti and Felciano teach all the limitations of claims 10 and 28 except for the use of HTML as a device specific markup language.

The Examiner takes Official Notice of the fact that HTML is a well-known web document language and that it would be obvious for one of ordinary skill in the art to at least allow transformations from the generic markup language described in Giannetti into basic HTML to support the most common web document standard.

The Examiner supports the taking of Official Notice with the evidence of Lo et al. (US 20020023157). Paragraph 25 of the document specifically discusses a mobile device using HTML to view webpages. Further, in Eldridge et al. (US 6421716) in the third full paragraph of Col. 9, it is disclosed that HTML is transmitted to a mobile computing device.

Response to Arguments

5.   Applicant's arguments filed 4/16/2008 have been fully considered but they are not persuasive.

6.   The Examiner maintains the rejection of claims under 35 USC 101 as stated above. The 'apparatus' claimed by Applicant still maps back to the 'adaptation framework' described on pages 15-16. The adaptation framework is merely a set of software code.

7.   The Examiner has provided evidence as required for the rejections of claims 10 and 28 to support the Official Notice.

8.   Regarding the arguments made to Giannetti and Falciano, the Examiner did not argue that Giannetti disclosed "one HTTP-request parameter", as it is in bold, and the rejection clearly stated that Gianetti did -not- disclose any of the limitations in bold. Falciano, which -does- teach using HTTP-request parameters to transmit data is cited in combination with the teachings of Giannetti to remedy that deficiency.

9.   In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10.   Regarding Applicant's arguments regarding Felciano, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

11.   The Examiner will attempt to clarify his position regarding the combination of Giannetti and Falciano as regards the limitation cited by Applicant. Giannetti discloses having the information necessary to derive the values of the HTTP-request parameters, but does not disclose the use of HTTP-request parameters. However, Falciano -does- disclose the use of HTTP-request parameters with an event name and value. In the combination of Falciano and Giannetti, the HTTP-request parameters -must- be derived from the generic description, because they are generated from the document itself, which is in turn generated by the generic description.

12.   If the Applicant believes that a further discussion of the prior art of record would assist prosecution and/or the understanding of the Examiner's position, the Examiner invites Applicant to schedule an interview.

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MICHAEL E. KEEFER whose telephone number is

(571)270-1591. The examiner can normally be reached on Monday through Friday

9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 6/30/2008

/Joseph E. Avellino/
Primary Examiner, Art Unit 2146